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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/670,433

09/24/2003

Jan Weber

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EXAMINER

TYSON, MELANIE RUANO

ART UNIT

PAPER NUMBER

3773

NOTIFICATION DATE

DELIVERY MODE

04/14/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/670,433	<b>Applicant(s)</b> WEBER ET AL.	
	<b>Examiner</b> Melanie Tyson	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 19-43 is/are pending in the application.
- 4a) Of the above claim(s) 19-33 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 34-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 14 October 2008 has been entered. Claims 12-18 are canceled. Claims 19-29 are withdrawn from consideration. New claims 41-43 have been added.

### ***Election/Restrictions***

Applicant's election **without traverse** of Group I, claims 1-11 and 34-42, in the reply filed on 12 February 2009 is acknowledged. Claims 30-33 and 43 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-11 and 34-42 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 7, and 9** are rejected under 35 U.S.C. 102(b) as anticipated by **Young et al. (U.S. Patent No. 5,817,017)**. Young discloses an implantable medical device (see entire document) comprising a support structure (tube) formed such that magnetic field changes proximate the support structure are substantially unobstructed, and a paramagnetic material (for example, gadolinium; see column 9, lines 43-44) embedded into at least part of the support structure (for example, see column 3, lines 48-57 and column 6, lines 12-15 and 36-48).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Young et al.**

Regarding claim 8, Young discloses the claimed invention except for a ferromagnetic material. Young suggests that ferromagnetic material is well known in the

art for making devices visible under MRI (for example, see column 1, lines 38-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use ferromagnetic material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

**Claims 2-6, 10, 11, and 34-40** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Young et al. in view of Pacetti (Patent No. 7,156,869 B1)**.

Young discloses the claimed invention (regarding claims 34 and 36-38, see rejection above for similar limitations) except that the implantable device comprises a stent that may be formed from a metallic or biodegradable material. Pacetti discloses an implantable stent (see entire document) and suggests that metallic and biodegradable materials are well known in the art for forming such devices (for example, see column 10, lines 3-17). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply Young's technique to a stent, since stents are well known implantable devices, as evidenced by Pacetti. Doing so would render Pacetti's stent detectable by MRI techniques. With further respect to claims 3, 4, 6, and 34-40, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the tubular structure of a metallic or biodegradable material as recited, since it has been held to be within the general skill of a worker in the art to select known materials on the basis of its suitability for the intended use as a matter of design choice.

Regarding claims 5, Young discloses the tubular structure may be made of a polymer and ceramic materials (for example, see column 6, line 43).

Regarding claims 10, 11, 39, and 40, Young recognizes that the magnetic material may be dispersed uniformly throughout the device or dispersed in a pre-selected pattern, to portions of the device that are desired to be viewed with magnetic imaging techniques (for example, see column 3, lines 14-22). Therefore, if only the ends of the implantable device are desired to be viewed with magnetic imaging techniques, it would have been obvious to one having ordinary skill in the art to apply the magnetic material only to those portions.

**Claims 41 and 42** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pacetti (Patent No. 6,712,844 B2) in view of Young et al.** Pacetti discloses a stent comprising a tubular structure having a plurality of rings of electrically conductive material, connectors of electrically conductive material extending between and connecting adjacent rings, and electrical discontinuities, comprising insulating material (for example, see Figure 3, column 5, lines 56-57, column 6, lines 5-8, and column 7, lines 1-3 and 28-43). Pacetti fails to disclose magnetic material embedded into the end portions of the tubular structure.

Young et al. discloses tubular insertable and implantable devices (see entire document). Young teaches embedding magnetic material into the tubular structures in order to enhance detectability when viewed with MRI techniques (for example, see column 3, lines 16-17). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to embed magnetic material into

Pacetti's tubular structure. Doing so would enhance detectability during imaging, thus enhancing proper placement/deployment of the device.

With further respect to claim 41, Young recognizes that the magnetic material may be dispersed uniformly throughout the device or dispersed in a pre-selected pattern, to portions of the device that are desired to be viewed with magnetic imaging techniques (for example, see column 3, lines 14-22). Therefore, if only the ends of the implantable device are desired to be viewed with magnetic imaging techniques, it would have been obvious to one having ordinary skill in the art to apply the magnetic material only to those portions.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./  
Examiner, Art Unit 3773  
April 8, 2009

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773